

REMARKS

Claims 1, 39, 47, and 54-56 have been amended. Claims 52-53 have been canceled. As such, claims 1-2, 38-51, and 54-60 are pending. No new matter has been added by these amendments. Applicants respectfully submit that all pending claims are now in condition for allowance.

Applicants would like to thank the examiner for participating in the telephone interview on November 21, 2005, during which it was agreed that the determination to make the Office Action "final" was improper. Pursuant to that discussion, Applicants respectfully submit that amendments to independent claims 1, 39, and 47 should be entered.

Office Action Was Improperly Made Final

The Office Action mailed August 19, 2005 purported to be final under MPEP § 706.07(a). However, that determination of finality was improper under MPEP § 706.07(a). In the Office Action mailed August 19, 2005, independent claim 39 was rejected for the first and only time, and claim 39 was never amended throughout the prosecution leading up to that Office Action. Under MPEP § 706.07(a), the Office Action could not be "final" when independent claim 39 was never amended and was rejected only one time. Applicants must be provided due process to address such a rejection. Accordingly, the amendments to independent claims 1, 39, and 47 should be entered.

Allowable Subject Matter

The Office Action indicated that independent claims 2 and 38 were allowed. Applicants note that claims 57-60 depend from allowed claim 38 and are thus allowable over the prior art of record.

The Office Action also indicated that dependent claims 43, 45, 46, 48-50, 53-56, and 58 would be allowable if rewritten in independent form. Applicants note that a significant portion of allowable subject matter from dependent claim 53 has been added to independent claim 1.

Claims 1 and 54-56

Independent claim 1 has been amended to include the allowable subject matter of dependent claim 53. Further, independent claim 1 has been amended to describe a viscosity of “about 2000 to about 16000 cp,” which was originally recited in claim 1 as filed. The Office Action mailed August 19, 2005 indicated that Nendl et al. (U.S. Patent No. 4,946,696), Osada et al. (U.S. Patent No. 5,070,230), Hoy (U.S. Patent No. 6,063,412), and Quinlivan (U.S. Patent No. 4,285,978)—alone or in combination—fail to teach an edible ink composition comprising “less than about 20% by weight water” and “about 1% to about 10% by weight of at least one emulsifier,” as described in allowable dependent claim 53. Applicants also note that this subject matter was deemed allowable over Weinstein et al. (U.S. Patent No. 6,251,452) in the earlier Office Action mailed February 9, 2005.

Amended independent claim 1 describes subject matter that is not disclosed or suggested by the prior art of record. As such, independent claim 1 and dependent claims 54-56 are in condition for allowance.

Claims 39-46

Independent claim 39 has been amended to describe an article that includes an edible ink “comprising less than about 20% by weight water and about 1% to about 10% by weight of at least one emulsifier.” Accordingly, amended claim 39 is patentable over the prior art of record for substantially the same reasons as allowable dependent claim 53. As such, independent claim 39 and dependent claims 40-46 are in condition for allowance.

Claims 47-51

Independent claim 47 has been amended to describe a lithographic printing process involving an edible ink that “comprises less than about 20% by weight water and about 1% to about 10% by weight of at least one emulsifier.” Accordingly, amended claim 47 is patentable over the prior art of record for substantially the same reasons as allowable dependent claim 53. As such, independent claim 47 and dependent claims 48-51 are in condition for allowance.

Conclusions

Pending independent claims 1, 39, and 47 each define an invention that is patentable over the prior art of record, as do dependent claims 52-56 (depending from claim 1), dependent claims 40-46 (depending from claim 39), and dependent claims 48-51 (depending from claim 47). Thus, in addition to the previously allowed claims 2, 38, and 57-60, Applicants request that the Examiner allow claims 1 and 39-56.

Because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. As such, Applicants hereby specifically reserves the right to prosecute claims of different or broader scope in a continuation application. The Examiner should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicants' position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Examiner, based on the claim amendments herein.

Enclosed is a \$120 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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Michael T. Hawkins
Reg. No. 57,867

Fish & Richardson P.C., P.A.
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696